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09/980,252	02/21/2002	Yasumasa Mizushima	SON-2058/YAM	9700

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EXAMINER

GORT, ELAINE L

ART UNIT	PAPER NUMBER
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3687

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/980,252	Applicant(s) MIZUSHIMA ET AL.	
	Examiner Elaine Gort	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 75-84 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 75-84 recite a method, not within the technological arts. A process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Neither of these requirements are met by the claims, therefore the claims does not qualify as a statutory process and do not positively recite the subject matter that is being transformed, by identifying the material that is being changed to a different state. In re Bilski Fed. Cir. 2008, 2007-1130. The transformation of data into a draft for bill of lading is not transforming underlying subject matter as no article or materials are transformed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 75-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 75 recites the limitation "said physical distribution trader site" in line 7.

There is insufficient antecedent basis for this "site" limitation in the claim.

Claims 76-84 recites the limitation "the automatic drafting method" in line 1.

There is insufficient antecedent basis for this limitation in the claim.

Claim 79 recites the limitation "said shipping instruction information" in line 1.

There is insufficient antecedent basis for this limitation in the claim.

Claims 80, 81 and 83 recites the limitation "said physical distribution trader site".

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 75-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (The Path of Least Resistance, December 1989) in view of Gardner et al. (US 2002/0178034); Junger (US Patent 6,085,172) and Examiner's Official Notice.**

Hoffman discloses the claimed method of drafting a bill of lading, comprising:

Obtaining vessel schedule information including schedules from cargo consigners (the PIE-IDS networked export system obtains and stores vessel schedule

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information from participating carriers/partners in order for it to book fixed transit time schedules, which include schedules for the disclosed specific PIE truck picking up a shipment in L.A, and the "right ship" that it needs to be loaded onto. See section How the System Works.);

Performing pre-booking by providing information on shipping to a physical distribution trader (interested shippers call the PIE 800 number to get information on shipments);

Obtains booking information from the physical distribution trader that includes a booking number (shipper provides a complete shipping invoice that inherently has a number or other identifier construed to be a "booking number");

Confirms booking information (paper work is checked for errors);

Prepares a draft for bill of lading including booking information and distribution information (shipment moves with a single bill of lading, therefore it must be prepared which would include at least some of the booking information provided by the shipper, such as sender address, receiver address, etc...);

But is silent regarding: providing the shipper specific schedule information and obtaining the shipper's selected schedule; and the booking number, vessel schedule and "basic six information" being on the bill of lading.

Gardner et al. teaches, in paragraph [0057], that it is known in the art of booking vessels to use a computerized booking system to provide specific schedule options over a network with a portal and allow the interested party the ability to select their desired schedule with the benefit of automating the system and allowing the interested party the

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ability to pick the schedule they like the most. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of drafting a bill of lading of Hoffman with the computerized system and presentment of specific schedule information and selection of a desired schedule by the interested party as taught by Gardner et al., in order to automate the process and provide the shipper the ability to pick the schedule they like the most. (Note: for claim 82 the portal is defined as the customer's input apparatus, while for claims 83 and 84 the portal is defined as the apparatus receiving information from the customer).

Regarding the use of booking numbers, vessel schedules and "basic six information" on the bill of lading, these differences from the combination above are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The pre-booking, obtaining, confirming and preparing of a bill of lading steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the step of pre-booking, obtaining, confirming and preparing of a bill of lading using any type of data. Because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

ALTERNATIVELY (and additionally):

Junger teaches, in paragraph Detailed Description Text – DETX (29), that it is old and well known in the art of tracking items to reference the item by an invoice number with the benefit of allowing a customer the ability to identify the item based on their invoicing system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the bill of lading of Hoffman and Gardner et al., as modified above, with an invoice number as taught by Junger, in order to provide shippers the ability to identify their shipments based on their invoicing system.

Examiner takes Official Notice that it is old and well known in the art of shipping documents to include the vessel schedule on a document traveling with the item (for example airline tickets contain the flight schedule) to provide information about the booked transport; to include basic six information on a document traveling with the item to provide important shipping information such as mailing address, return address, number of items, names, dates., contents, etc...; and to use codes or numbers to identify bill of ladings. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the bill of lading of Hoffman, Gardner et al., and Junger, as modified above, with a vessel schedule, basic six information, and bill of lading number as taught by Examiner's Official Notice, in order to provide information about the booked transport and important shipping information for identification.

Response to Arguments

Applicant's arguments with respect to claims 75-84 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on 571/272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/
Primary Examiner, Art Unit 3687

Elaine Gort
Primary Examiner
Art Unit 3687

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